

## REMARKS

Reconsideration of this application is respectfully requested. The undersigned, on behalf of applicants, thanks the examiner for the helpful courtesies and remarks extended during the telephonic interview with the examiner on August 15, 2006. This amendment and the following remarks are believed consistent with the discussions during the interview.

Claims 1-9 and 36-61 are presently pending in this application. Claims 10-35 were previously canceled without prejudice due to an inadvertence in claim numbering and have been earlier presented as new claims 36-61. By this amendment, claims 43-46 again are presented for examination.

Claims 1-9, 36-42 and 47-61 stand withdrawn pursuant to restriction requirement, the restriction requirement having been made final.

In the office action, claims 43-46 have been rejected under 35 U.S.C. § 35 U.S.C. § 102(e) as anticipated over the Hofmann et al. reference entitled " Synthesis of Polyphosphazenes with Sulfonimide Side Groups" cited by examiner in Chem Abstract 137:217352.

Initially, it is respectfully submitted that 35 U.S.C. § 102(e) can not be relied on as a basis for anticipation. 35 U.S.C. § 102(e) states that a person shall be entitled to a patent unless:

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

Here, the cited Hofmann et al. reference is neither an application for patent, published under section 122(b), by another filed in the United States before the

invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent. In addition, the Hofmann et al. reference is not international application that designates the United States that was published in the English language. Accordingly, the Hofmann et al. reference can not be relied on to support a rejection under 35 U.S.C. § 102(e).

The Hofmann et al. reference also can not be relied on to support a rejection under any other section of 35 U.S.C. § 102. In this connection, 35 U.S.C. § 102(a) states:

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent

The Hofmann et al. published on the web on July 17, 2002. The publication date of Hofmann et al. therefore is within one year of the February 13, 2002 priority date of above-identified application. The literature reference to Hofmann et al. therefore is not a statutory bar.

As discussed in MPEP 716.10, a copy of which is enclosed for the convenience of the Examiner, a rejection based on a literature reference, unless it is a statutory bar, may be overcome by a showing that the reference was published either by applicant himself/herself or on his/her behalf. MPEP 716.10 also states that where the author of the reference being relied on is a different entity from applicant, the reference may be prior art under 35 U.S.C. § 102. MPEP 716.10, *however* (emphasis added), also teaches that:

“an affidavit under 37 CFR 1.132 may be submitted to show that the relevant portions of the reference originated with or were obtained from applicant.”

Applicants therefore respectfully submit that where the declarations show that the relevant portions of a reference authored by an entity different from applicants originated with or were obtained from applicants, and where the reference is less than

one year prior to the priority date of the applicant, then the reference can not be used against applicants.

Here, Applicants have previously submitted Declarations which show that the relevant portions of the Hofmann et al. reference originated with or were obtained from applicant. Those previously submitted declarations show that claimed phenoxy sulfonimide functionalized polyphosphazene copolymer  $[NP(ZR^2)_x(ZC_6H_4SO_2NR^1SO_2R_f)_{2-x}]_n$  where  $R_f$  is a  $C_1$ - $C_8$  perfluoroalkyl, where  $R^2$  is selected from the group consisting of  $-CH_2CH_3$ ,  $-C_6H_4CH_3$ ,  $-CH_2CH_2OCH_2CH_2OCH_3$ ,  $-CH_2CH_2OTHP$ ,  $-C_6H_4COOPr$ ,  $-CH_2CF_3$ ,  $-CH_2CF_2OCF_2CF_2OCF_3$ ,  $-C_6H_4CF_3$ ,  $-C_6F_5$ , and mixtures thereof,  $Z$  is  $O$  or  $NH$ , and  $R^1$  is  $Na$ , as well as its synthesis, is the work of all of the applicants and is directly attributable to all of the applicants. The Declarations therefore show that the sole inventors of the above-identified application are the named applicants.

Applicants, in accordance with MPEP 716.10, therefore respectfully submit that the Hofmann et al. reference should be withdrawn since the Declarations establish that the claimed sodium species and the method of making the phosphazene monomer and copolymer disclosed in the Hofmann et al. reference is directly attributable to applicants. Applicants therefore respectfully submit that Hofmann et al. is ineffective as a reference against any of claims 43-46, and should be withdrawn. See *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). Claims 43-46 therefore are not anticipated by Hofmann et al.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 43-46 have been rejected under 35 USC 112, second paragraph as indefinite. The examiner asserts that numerical ranges should be recited in connection with each of subscripts "x" and "n" in the claimed formula  $[NP(ZR^2)_x(ZC_6H_4SO_2NR^1SO_2R_f)_{2-x}]_n$ .

As is well known in the art of phosphazene chemistry, there are two possible substituent (side-groups) per P atom and those substituents may differ. See "Phosphorus-Nitrogen Compounds", Allcock, pub: Academic Press Inc., New York,

1972, pp 3-4, a copy of which is attached for the examiners convenience.

Since there are two substituent groups per P atom, then it would be clear to one of ordinary skill that x may be 0, 1, or 2 in the claimed formula

$[NP(ZR^2)_x(ZC_6H_4SO_2NR^1SO_2R_f)_{2-x}]_n$ . In this connection, where x is 0, then two " $ZC_6H_4SO_2NR^1SO_2R_f$ " substituents are attached to the P atom; where x is 2, two " $(ZR^2)$ " units are attached to the P atom; where x is 1, one " $(ZR^2)$ " substituent and one " $ZC_6H_4SO_2NR^1SO_2R_f$ " substituent is attached to the P atom. A polymer results when, as would be clear to one of ordinary skill in the art, more than one unit of the claimed formula  $[NP(ZR^2)_x(ZC_6H_4SO_2NR^1SO_2R_f)_{2-x}]_n$  is present in the polymer chain, i.e.,  $n > 1$ . In such a polymer, x also may be a non-integer between 0 and 2 that represents the average value for the entire polymer chain. Such values of x would be clear to those of ordinary skill. Again, see "Phosphorus-Nitrogen Compounds", Allcock, pub: Academic Press Inc., New York, 1972, pp 3-4.

In view of the above, applicants respectfully submit that one of ordinary skill would understand and recognize the range of possible values of the subscript x.

In connection with the subscript n, and as would be recognized by one of ordinary skill in the art, subscript n need not have a specific numerical value. This is because one of ordinary skill in the art recognizes that the number of units in a polymer chain may be any number greater than one.

In view of the forgoing, applicants respectfully submit that one of ordinary skill, given the claimed formula  $[NP(ZR^2)_x(ZC_6H_4SO_2NR^1SO_2R_f)_{2-x}]_n$ , would readily be able to determine the range of values of the x subscript so as to assess the metes and bounds of the claim. Applicants also respectfully submit that one of ordinary skill would clearly know that when n has an integer value greater than one that a polymer chain results and therefore would readily be able assess the metes and bounds of the claim.

Applicants submit that 35 USC 112, 2<sup>nd</sup> paragraph is satisfied if a person skilled in the field of the invention would reasonably understand the claim when read in the context of the specification. See Union Pac. Res. Co. v. Chesapeake Energy Corp., 236

F.3d 684, 692 (Fed. Cir. 2001) (the definiteness requirement set forth in § 112, 2<sup>nd</sup> paragraph, "focuses on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification"); Miles Lab., Inc. v. Shandon, 997 F.2d 870, 875 (Fed. Cir. 1993) (if the claims "reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more"); In re Moore, 58 C.C.P.A. 1042, 439 F.2d 1232, 1235 (CCPA 1971) (the indefiniteness inquiry asks whether the claims "circumscribe a particular area with a reasonable degree of precision and particularity").

Applicants respectfully submit that claims 43-46 satisfy the requirements of 35 USC 112, 2<sup>nd</sup> paragraph. Here, it is clear that a person skilled in the field of claims 43-46 would reasonably understand the scope of those claims when read in the context of the specification. It also is clear that claims 43-46 reasonably apprise those skilled in the art of the scope of the claims with a reasonable degree of precision and particularity. One of ordinary skill, when assessing the metes and bounds of the claims in light of the specification, therefore would readily be able to assess the range of the values of  $x$  and would know that  $n > 1$ .

In view of the forgoing, applicants respectfully submit that the claims are in condition of allowance. Such action is respectfully solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'John A. Parrish', with a stylized flourish at the end.

John A. Parrish  
Reg. No. 31, 918  
PH: 610-617-8960

claim or count is disclosed in an application involved in an interference and which explains the underlying factual basis for the opinion may be helpful and can be admitted. The weight to which the latter testimony may be entitled must be evaluated strictly on a case-by-case basis."

### 716.10 Attribution

Under certain circumstances an affidavit or declaration may be submitted which attempts to attribute an activity, a reference or part of a reference to the applicant. If successful, the activity or the reference is no longer applicable. When subject matter, disclosed but not claimed in a patent application filed jointly by S and another, is claimed in a later application filed by S, the joint patent or joint patent application publication is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or (f) unless overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention (see MPEP § 715) or an unequivocal declaration by S under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application. Disclaimer by the other patentee or other applicant of the published application should not be required but, if submitted, may be accepted by the examiner.

Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent or an application publication identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent or published application so as to justify a rejection under 35 U.S.C. 102(f).

However, it is incumbent upon the inventors named in the application, in response to an inquiry regarding the appropriate inventorship under 35 U.S.C. 102(f) or to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author, patentee, or applicant of the published application notwithstanding the authorship of the article or the inventorship of the patent or published

application. *In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship and it is then incumbent upon the applicant to provide "a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ... inventor" of the subject matter disclosed in the article and claimed in the application).

An uncontradicted "unequivocal statement" from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982). However, a statement by the applicants regarding their inventorship in view of an article, patent, or published application may not be sufficient where there is evidence to the contrary. *Ex parte Kroger*, 218 USPQ 370 (Bd. App. 1982) (a rejection under 35 U.S.C. 102(f) was affirmed notwithstanding declarations by the alleged actual inventors as to their inventorship in view of a nonapplicant author submitting a letter declaring the author's inventorship); *In re Carreira*, 532 F.2d 1356, 189 USPQ 461 (CCPA 1976) (disclaiming declarations from patentees were directed at the generic invention and not at the claimed species, hence no need to consider derivation of the subject matter).

A successful 37 CFR 1.132 affidavit or declaration establishing derivation by the author, patentee, or applicant of the published application of a first reference does not enable an applicant to step into the shoes of that author, patentee, or applicant of the published application in regard to its date of publication so as to defeat a later second reference. *In re Costello*, 717 F.2d 1346, 1350, 219 USPQ 389, 392 (Fed. Cir. 1983).

### EXAMPLES

The following examples demonstrate the application of an attribution affidavit or declaration.

#### Example 1

During the search the examiner finds a reference fully describing the claimed invention. The applicant is the author or patentee and it was published or patented less than one year prior to the filing date of the application. The reference cannot be used against applicant since it does not satisfy the 1-year time requirement of 35 U.S.C. 102(b).

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Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent or an application publication identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent or published application so as to justify a rejection under 35 U.S.C. 102(f).

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